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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,988	03/31/2005	Rohit V. Kapoor	CA920020072US1	2266

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IBM CORPORATION  
INTELLECTUAL PROPERTY LAW  
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EXAMINER
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LI, SUN M

ART UNIT	PAPER NUMBER
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4115

MAIL DATE	DELIVERY MODE
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07/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,988	<b>Applicant(s)</b> KAPOOR ET AL.	
	<b>Examiner</b> SUN LI	<b>Art Unit</b> 4115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The following is a non-final, first office action on the merits, in response to application filed 3/31/2005. Per amendments to the claims filed on 3/31/2005, claims 1-28 are presented for examination and are currently pending.

#### ***Priority***

The Applicant claims benefit of PCT/GB03/04336 filed on 10/03/2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 3/31/2005 was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 28 recites an encoding template which is unclear a system or a software program. Examiner finds claim 28 void of process/apparatus structure and fails to belong to an appropriate statutory subject class. Therefore, claim 28 is rejected under non-statutory subject matter. See MPEP 2106.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lahti et al. (hereinafter Lahti, International Pub. No. WO 98/42173).**

As per claim 1, Lahti discloses a method for generating an SMS business message for processing by a software application comprising the steps of:

- a data collection interface accepting outgoing instructions and outgoing data from said software application (Fig.1, user interface; p.3, lines 11-13, sending, reply; p.6, lines 29-31, database language);
- a message encoding engine encoding said outgoing instructions and outgoing data from said software application using an encoding template to generate the SMS

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business message as a categorized SMS message formatted for processing by a data processing system (Fig.3, p.7, lines 26-31, payment template); and

- a dispatcher runtime processor processing said SMS business message for transmission over a network to a recipient (Fig.3, p.7, lines 26-33, transferred as a short message).
- As per claim 2, Lahti further discloses the method of claim 1 further comprising the step of transmitting the SMS business message over a network to a recipient (Fig.3, p.7, lines 26-33, transferred as a short message).

As per claim 3, Lahti further discloses the method of claim 2 wherein the SMS business message comprises:

- a message text entry field for alerting the recipient about a commerce event (p.2, line 12, banking service); and
- an encryption string entry field (p.3, lines 25-26, user name, password).

As per claim 4, Lahti further discloses the method of claim 3 wherein the SMS business message further comprises:

- a response indicator label (p.5, line 20, command)
- a recipient data entry field associated with said response indicator label (p.3, line 25, username);
- a recipient authentication indicator label (p.5, line 20, command); and

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- a recipient authentication data entry field associated with said recipient authentication indicator label (p.3, line 26, password).

As per claim 5, Lahti further discloses the method of claims 3 wherein said encryption string entry field is adapted to accept communication session identification data (p.6, line 24, verifies; lines 25-26, identified).

As per claim 6, Lahti further discloses the method of claim 5 wherein said session identification data may be used to associate a response to a sent message (p.6, line 26, authorized to use).

As per claim 7, Lahti further discloses the method of claim 6 wherein said session identification data may be used to identify a software application to process a response to a sent message (p.6, line 29-30, database language, response).

As per claim 8, Lahti further discloses the method of claim 3 wherein said encryption string entry field is adapted to accept security data (p.10, line 33, receiver's secret key).

As per claim 9, Lahti further discloses the method of claim 4 wherein said recipient authentication data entry field is adapted to accept a personal identification number (PIN) from said recipient (p.7, line 1, account number).

As per claim 10, Lahti further discloses the method of claim 4 wherein the SMS business message further comprises:

- a first recipient data entry field associated with said response indicator label, wherein said first recipient data entry field is adapted to allow a response to be inserted by a responding recipient (p. 7, line 25, username); and
- a second recipient data entry field associated with said authentication indicator label, wherein said second recipient data entry field is adapted to allow a response to be inserted by a responding recipient (p. 7, line 25, password).

As per claim 11, Lahti further discloses the method of claim 1 wherein the encoding template comprises: categorisation meta data defining a categorisation of SMS business messages, wherein:

- the categorisation represents a specific businesses intended usage (p.1, line 25, telephone banking);
- categorisation meta data provides a definition of the categorization (Fig. 2, balance inquiry); and
- the categorisation meta data is parsable by said data processing system for generating SMS business messages (col.2, lines 1-3, transferring, short message type messages).

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As per claim 12, Lahti further discloses the method of claim 11 wherein the encoding template further comprises:

- a message entry field for insertion of a message entry of full SMS message length for access by a recipient, wherein ( p.4, line 22, short character string);
- said template provides an additional field in said SMS business message for categorisation meta data (p.4, line 24, a header part); and
- said meta data provides instructions for encoding a business intended usage of an SMS business message (p.5, line 19-20, information needed, command part, interpreted to mean).

As per claim 13, Lahti further discloses the method of claim 12 wherein said meta data includes instructions for dispatching said SMS business message including instructions selected from:

- a message priority (p.7, line 10, a code, particular reply relates to);
- a delivery time (p.8, line 32, time);
- a number of recipients (p.7, line 13, user);
- a delivery channel (p.7, line 5-7, TCP/IP, short message service center, mobile switching center, base station);
- a need for confirmation (p.8, line 29, acknowledge) ;
- a need for authentication (p.8, line 22, username, password);
- a need for encryption (p.11, line 2-3, public key, secret key); and
- an intended web application to handle a response (Fig. 1, self service unit).



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As per claim 14, Lahti further discloses the method of claim 12 wherein said meta data includes instructions for identifying a software application intended to handle a response to said SMS business message (Fig. 1, self service unit; p.6, line 29, database language).

As per claim 15, Lahti further discloses the method of claim 2 further comprising the steps of:

- a server receiving a response messages from a recipient in response to the transmission of said SMS business message (Fig. 1, user interface server);
- decoding an encryption string within said SMS response message with an appropriate key to verify that said response message is directed to said server (p.11, line 7, decrypts);
- extracting identification from said SMS response message for processing information in said response (p.8, line 24, identified) ;
- identifying and obtaining a corresponding inbound template for said response message from said server (p.8, line 24, authorized to use);
- parsing said response message with said inbound template to extract incoming data and incoming instructions contained in said response message, if any, for processing said data and instructions (p.7, line 17, command; p.8, line 29, reply creates an acknowledge message).

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As per claim 16, Lahti further discloses the method of claim 15 further comprising the forwarding said incoming data and incoming instructions to an application server for processing (p.8, line 29, reply creates an acknowledge message).

As per claim 17, Lahti further discloses the method of claim 16 wherein said SMS response message includes:

- an encryption string encoded with an encoding key (p.10. line 30, encryption, public key) ;
- identification of a software application capable of processing said response (Fig. 1, self service unit; p.6, line 29, database language); and
- user authentication information (p.8, line 22, username, password).

As per claim 18, Lahti further discloses the method of claim 17 wherein:

- said server has access to said encoding key (p.10, line 29-30, encryption, public key); and
- said server has access to said inbound template (p.7, line 31-32, payment template).

As per claim 19, Lahti further discloses the method of claim 2 further comprising the steps of:

- a server receiving an SMS response message from a recipient in response to the transmission of said SMS business message ( Fig. 1, user interface server); and

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- a response tracking database tracking said SMS response message in a response tracking database (Fig. 2. p.6, line 29-30, database language, response).

As per claim 20, Lahti further discloses the method of claim 19 further comprising the steps of:

- an inbound template database identifying and parsing said SMS response message (p.8, line 22-24, identified; line 29, acknowledge) ;
- said dispatcher processing said SMS response message and forwarding said SMS response messages to said software application ( p.11, line 5, encrypt, sent).

As per claim 21, Lahti discloses means for generating an SMS business message for processing by a software application comprising:

- means for a data collection interface accepting outgoing instructions and outgoing data from said software application (Fig.1, p. 2, lines 10-13, user interface server; p.3, lines 11-13, sending, reply; p.6, lines 29-31, database language);
- means for a message encoding engine encoding said outgoing instructions and outgoing data from said software application using an encoding template to generate the SMS business message as a categorized SMS message formatted for processing by a data processing system (Fig.1, banking application computer; p.7, lines 26-31, payment template ); and

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- means for a dispatcher runtime processor processing said SMS business message for transmission over a network to a recipient (Fig.3, p.7, lines 26-33, transferred as a short message, user terminal).

As per claim 22, Lahti further discloses a computer program product directly loadable into the internal memory of a digital computer, comprising software code portions for performing, when said product is run on a computer, the method of claims 1 (p.2, line 27, data communication connection, transfer data).

As per claim 23, Lahti discloses a method for processing an incoming e-commerce SMS response message received by a server from a recipient responding to an outgoing e-commerce SMS message, comprising:

- receiving said SMS response message (p.8, line 16-18, short message);
- decoding an encryption string within said SMS response message with an appropriate key to verify that said response message is directed to said server (p.11, line 7, decrypts);
- extracting identification from said SMS response message for processing information in said response (p.8, line 24, identified);
- identifying and obtaining a corresponding inbound template for said response message from said server (p.8, line 24, authorized to use);;
- parsing said response message with said inbound template to extract data and instructions contained in said response message, if any, for processing said data

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and instructions (p.7, line 17, command; p.8, line 29, reply creates an acknowledge message).

As per claim 24, Lahti discloses an SMS commerce message format for use in sending a commerce message over a network to a recipient comprising:

- a message text entry field for alerting a recipient about a commerce event (p.2, line 12, banking service);
- an encryption string entry field (p.3, lines 25-26, user name, password).
- a response indicator label (p.5, line 20, command);
- a recipient data entry field associated with said response indicator label (p.3, line 25, username);
- a recipient authentication indicator label (p.5, line 20, command); and,
- a recipient authentication data entry field associated with said recipient authentication indicator label (p.3, line 26, password).

As per claim 25, Lahti further discloses the SMS message format of claim 24 wherein said encryption string entry field is adapted to accept communication session identification data (p.6, line 24, verifies; lines 25-26, identified).

As per claim 26, Lahti further discloses the SMS message format of claim 24 wherein said encryption string entry field is adapted to accept security data (p.10, line 33, receiver's secret key).

As per claim 27, Lahti further discloses the SMS message format of claim 24 wherein said recipient authentication data entry field is adapted to accept a PIN number from said recipient (p.7, line 1, account number).

As per claim 28, Lahti discloses an SMS universal encoding template for encoding outbound SMS business messages for a data processing system for transmission over a network; comprising:

- categorization meta data defining a categorization of outbound SMS messages (Fig. 2, balance inquiry);
- said categorization representing a specific businesses intended usage (p.1, line 25, telephone banking); and
- said categorization meta data providing definitions of messages and instructions that are parsable by said data processing system for generating SMS business messages (col.2, lines 1-3, transferring, short message type messages).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN LI whose telephone number is (571) 270-5489. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00PM Eastern Standard Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL  
Patent Examiner, AU 4115

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 4115